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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,188	06/30/2005	Tatsuro Uchida	03500.103081.	4934
5514	7590	10/23/2008		
FITZPATRICK CELLA HARPER & SCINTO			EXAMINER	
30 ROCKEFELLER PLAZA			KIANNI, KAVEH C	
NEW YORK, NY 10112			ART UNIT	PAPER NUMBER
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MAIL DATE		DELIVERY MODE		
10/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,188	<b>Applicant(s)</b> UCHIDA, TATSURO
	<b>Examiner</b> K. Cyrus Kianni	<b>Art Unit</b> 2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-2 and 4 is/are rejected.
- 7) Claim(s) 17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1668)           | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

claim 1 is indefinite since the limitation 'wherein the substrate and the light emitting element are made of the same semiconductor material' implies that the substrate and the emitting element have the same "semiconductor material" while the specification is lacking such teaching and while also the new claim 17 indicates that they actually are not the same material, thus making the scope of the claim confusing/indefinite.

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 17 is allowable because the prior art of record, taken alone or in combination, fails to disclose or render obvious wherein the substrate comprises a GaAs layer and a semiconductor layer, and the light emitting element is formed on the GaAs layer and the optical path transforming structure is formed on the semiconductor layer in combination with the rest of the limitations of the base claim.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Ouchi (US 20030039455 A1; equivalently/analogously in EP 1286194 A2 and US 6829398 B2 as usc 102(e) references).

Ouchi teaches an optical element device comprising (shown in fig. 2) a light emitting element (shown in at least fig. 2); and a substrate 3 mounting the light emitting element 2 thereon and having an optical path transforming structure 4, wherein an integral semiconductor body comprising each of the light emitting element and the substrate (shown in fig. 2; wherein item 7 is a semiconductor substrate, see 0073), whereby a surface of the light emitting element and a surface of the substrate are attached to each other (shown in fig. 2, see surface of item 2 is attached to the substrate 3), and wherein the optical path transforming structure is configured to changing a light proceeding direction in order to couple light from the light emitting element with a light receiving element (shown in at least fig. 2B); wherein the substrate and the light emitting element are made of the same semiconductor material (see parag., **0073** wherein substrate 7 supporting the light emitting element 5 is made of semiconductor material).

Ouchi further teaches wherein the substrate is configured such that it does not absorb light being propagated from the light emitting element (shown in figure 2 in which it propagates light); a growth substrate of a semiconductor layer for forming said

optical element (see parag. 0071-0073+); wherein said growth substrate is formed by using a compound semiconductor (see at least 0071-0073+).

***Response to Arguments and Amendment***

Applicant's argument filed on 6/30/08 have been fully considered but regarding Ouchi are not persuasive. Applicant alleges that with new amendment Ouchi does not teach a substrate and the optical element both made of semiconductor material.. The Examiner responds indeed Ouchi teaches a substrate 7 mounting the light emitting element 2 thereon and having an optical path transforming structure wherein an integral semiconductor comprising each of the light emitting element and the substrate in which an integral semiconductor comprising each of the light emitting element and the substrate whereby a surface of the light emitting element and a surface of the substrate are attached to each other material (see parag., 0073 wherein substrate 7 supporting the light emitting element 5 is made of semiconductor material).

***THIS ACTION IS MADE FINAL***

This action in response to applicant's amendment made FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Cyrus Kianni whose telephone number is 571-272-2417. The examiner can normally be reached on 9:30-19:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/K. Cyrus Kianni/

Primary Examiner, Art Unit 2883

October 20, 2008